

### REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 2, 4, 8, 9, 11, 15, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0143924 to Iga in view of U.S. Patent No. 6,101,576 to Kobayashi et al. (hereinafter “Kobayashi”). Claims 3, 10 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iga in view of Kobayashi in further view of U.S. Patent No. 6,130,757 to Yoshida et al. (hereinafter “Yoshida”) and claims 5-7, 12-14 and 19-21 stand rejected under the same as being unpatentable over Iga in view of Kobayashi in further view of U.S. Patent No. 6,675,382 to Foster.

By this amendment, claims 1, 8 and 15 have been amended to further define the subject matter Applicant regards as the invention. Support for the amendments to these claims can at least be found on page 11, line 15 to page 12, line 25 and Fig. 6 of the present specification. New claims 22-27 have been added and claims 2-7, 9-14 and 16-21 remain unchanged.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Thus, claims 1-27 are presently pending in this application for consideration.

Applicant respectfully submits that each of the pending claims is patentably distinguishable over the cited references as required by § 103. Applicant further submits that none of the cited references, whether considered alone or in combination, teaches or suggests Applicant’s claimed data updating method, image forming apparatus and image forming system for updating data arranged such to: (1) *receive electronic mail that calls for updating of the data stored in the first memory from an external device*; (2) *determine whether or not the image forming apparatus is in a standby state after receiving the electronic mail*; and (3) *download updating data from a device on a network based on contents of the*

*electronic mail when it is determined that the image forming apparatus is in a standby state.* Each of the independent claims, namely claims 1, 8 and 15 includes this arrangement. By contrast, the cited references fail to teach or suggest this claimed arrangement. Accordingly, each of the claims is patentably distinguishable over the cited references. This distinction will be further described below.

### **THE CLAIMS DISTINGUISH OVER THE CITED REFERENCES**

In the Office Action, all of the claims are rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of the Iga, Kobayashi, Yoshida and Foster references. Applicant respectfully traverses the rejections of these claims, and submits that these claims are allowable for at least the following reasons.

Applicant relies on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

### **The Cited References Do Not Suggest All Claim Recitations**

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained below), the cited references still do not meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

The presently claimed invention is directed to a data updating method, an image forming apparatus and an image forming system for updating data. The image forming

apparatus includes a first memory, a second memory, a network interface, an updating section and a processing section. The image forming apparatus of claim 8 has been further amended to include a receiving section and a state determining section. According to one embodiment of the present invention as recited in amended independent claim 8: (1) *the receiving section receives electronic mail that calls for updating of the data stored in the first memory from an external device*; (2) *the state determining section determines whether or not the image forming apparatus is in a standby state after receiving the electronic mail*; and (3) *the data updating section executes updating processing for the data stored in a first memory based on the updating data downloaded by a network interface when it is determined that the image forming apparatus is in a standby state by the state determining section*.

Independent apparatus claim 15 has been amended in a similar manner. Independent claim 1 recites a similar arrangement in the context of a method claim. With this arrangement, the updating processing operation can be performed in a stable and uninterrupted manner. (Specification, page 12, lines 23-25).

The Office Action correctly recognizes that Iga does not disclose the second memory that saves the data, which has been stored in the first memory and the processing section that rewrites the data saved in the second memory which is unupdated data stored in the first memory into the first memory when an error occurs. Applicant respectfully submits that Iga also fails to disclose the newly claimed receiving and state determining sections recited in independent claim 8.

While Kobayashi does teach recovering data when a power supply is cut-off, that is all that Kobayashi teaches in this regard. Kobayashi is interested only in providing a system to retrieve cache data when power is cut-off, and is uninterested in determining an appropriate time to update data via electronic mail. Kobayashi is entirely directed towards a control unit for a cache memory system where first and second caches are used to retrieve data when power is cut-off. That is all. Even assuming *arguendo* that Kobayashi did teach the claimed second memory and the processing section as recited in the claims (which it does not), Kobayashi simply does not remedy the deficiencies of Iga because Kobayashi fails to disclose or suggest: (1) *the receiving section receives electronic mail that calls for updating of the data stored in the first memory from an external device*; (2) *the state determining section*

*determines whether or not the image forming apparatus is in a standby state after receiving the electronic mail; and (3) the data updating section executes updating processing for the data stored in a first memory based on the updating data downloaded by a network interface when it is determined that the image forming apparatus is in a standby state by the state determining section.*

The Yoshida and Foster references address specific features of the method, apparatus and system described above which the Office Action alleges were not found in the combination of Iga and Kobayashi. However, whether considered alone or in combination, neither of these references discloses the claimed features recited above and thus, can not remedy the deficiency of the combination of Iga and Kobayashi. Thus, independent claims 1, 8 and 15 and all claims dependent therefrom are allowable.

In sum, even if the first requirement of MPEP § 2143 is satisfied, the third requirement of MPEP § 2143 is not satisfied in the Office Action, since the cited references do not teach each and every element of the present invention. Thus, the present claims are allowable.

#### Lack of Suggestion or Motivation to Modify or Combine the References

MPEP § 2143.01 states that “the **prior art must** suggest the desirability of the invention.” (MPEP § 2143.01, subsection 1, emphasis added.) The Office Action appears to rely solely on the Applicant’s disclosure for motivation to modify the reference to arrive at the image forming apparatus, system and method for updating data as claimed. The Office Action cites nothing in the **prior art** that provides motivation to modify the reference to arrive at the invention recited in independent claims 1, 8 and 15. There is nothing in either of the cited references that suggests the desirability of Applicant’s invention, and the Office Action does not provide evidence that motivation to modify Iga is in the knowledge generally available to one of ordinary skill in the art.

Applicant submits that the motivation proffered in the Office Action to combine the references is not sufficient. The Office Action states no reason why the references should be combined other than: the combination “incorporate image processing.” However, Applicant

respectfully submits that the fact both references are related to image processing is not the same as *a reason why* one of ordinary skill in the art would be motivated to combine the references. If motivation to combine references to establish a *prima facie* case of obviousness could merely be satisfied by the mere fact that references can be combined, the first requirement (and second requirement) of MPEP § 2143 would be completely vitiated.

In contrast to the can be combined analysis proffered in the Office Action, the MPEP specifically states that “the prior art must suggest the desirability of the claimed invention.” The Office Action’s analysis does not identify where the prior art suggests the desirability of an image forming apparatus, system and method for updating data according to the independent claims.

In summary, because of the lack of suggestion or motivation in the prior art to modify the reference, the first requirement of MPEP § 2143 has not been met and, hence, a *prima facie* case of obviousness has not been established.

Applicant respectfully submits that each of the pending independent claims 1, 8 and 15 is patentably distinguishable over the cited references and thus, allowable. Moreover, since independent claims 1, 8 and 15 are allowable, claims 2-7, 9-14 and 16-27 are also allowable by virtue of their direct or indirect dependence from allowable independent claims 1, 8 and 15 and for containing other patentable features. Further remarks regarding the asserted relationship between any of the claims and the cited references is not necessary in view of their allowability. Applicant’s silence as to the Office Action’s comments is not indicative of being in acquiescence to the stated grounds of rejection.

Accordingly, this application is in condition for allowance and Applicant respectfully requests early notice to that effect.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.



The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a

check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date June 30, 2006

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